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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,772	07/21/2000	Raynold M. Kahn	PD-200045	3987

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PATENT DOCKET ADMINISTRATION RE/R11/A109  
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EXAMINER

TRAN, ELLEN C

ART UNIT PAPER NUMBER

2134

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2/3

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/620,772		KAHN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Ellen C Tran		2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. This action is responsive to communication: amendment filed on 1 June 2004, with original application filed on 21 July 2000.
2. Claims 1-42 are currently pending in this application. Claims 1, 17, and 28 are independent claims.
3. Applicant's amendment to specification is accepted.

**Response to Arguments**

4. Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.

**Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

6. **Claims 1-42** are rejected under 35 U.S.C. 102(e) as being anticipated by Akins, III et al. U.S. Patent No. 6,560,340 (hereinafter '340).

**As to independent claim 1, "A method of storing program material for subsequent replay, comprising the steps of:"** is taught in '340 col. 7, lines 48-55;

**"(a) accepting encrypted access control information and the program material encrypted according to a first encryption key, the access control information including a first encryption key and control data"** is shown in '340 col. 4, lines 26-33;

**“(b) decrypting the received access control information to produce the first encryption key; (c) decrypting the program material using the first encryption key; (d) re-encrypting the program material according to a second encryption key; (e) encrypting the second encryption key according to a third encryption key to produce a fourth encryption key; and (f) providing the re-encrypted program material and the fourth encryption key for storage”** is disclosed in ‘340 col. 6, lines 24-54.

As to dependent claim 2, **“wherein the encrypted access control information further comprises temporally-variant control data, and the method further comprises the steps of: decrypting the received access control information to produce the temporally variant control data; and modifying the temporally variant control data to generate temporally-invariant control data”** is taught in ‘340 col. 28, line 43 through col. 29, line 39.

As to dependent claim 3, **“wherein steps (b) and (e) are performed ins a conditional access module”** is shown in ‘340 col. 6, lines 24-53.

As to dependent claim 4, **“wherein the conditional access module is implemented on a smartcard communicatively coupleable to a tuner and a media storage device”** is disclosed in ‘340 col. 21, lines 1-14.

As to dependent claim 5, **“wherein the access control information further comprises metadata describing at least one right for the program material”** is shown in ‘340 col. 4, lines 50-61.

As to dependent claim 6, **“further comprising the step of generating the second encryption key at least in pant from the metadata”** is disclosed in ‘340 col. 4, lines 50-61.

As to dependent claim 7, **“wherein steps (b)-(f) are performed in response to a pre-buy Message”** is taught in ‘340 col. 12, lines 39-67.

As to dependent claim 8, “wherein the access control information further comprises metadata describing at least one right for the program material and the method further comprises the step of: generating replay right data from the metadata” is shown in ‘340 col. 31, lines 7-24.

As to dependent claim 9, “wherein the replay right dam is further generated from pre-buy data” is disclosed in ‘340 col. 31, lines 7-24.

As to dependent claim 10, “further comprising the steps of retrieving the stored re-encrypted program material and the fourth encryption key; decrypting the fourth encryption key using the third encryption key to produce the second encryption key; and decrypting the re-encrypted material using the second encryption key” is taught in ‘340 col. 6, lines 24-53.

As to dependent claim 11, “wherein the step of decrypting the fourth encryption key using the third encryption key to produce the second encryption key is performed in response to a subscriber request to access the program material” is shown in ‘340 col. 30, lines 38-67.

As to dependent claim 12, “wherein the access control information further comprises metadata describing at least one right for the program material, the subscriber request to access the program material comprises buy data, and the method further comprises the steps of; generating replay right data from the metadata; accepting the buy data; comparing the buy data with the replay right data; and decrypting the fourth encryption key using the third encryption key to produce the second encryption key according to the comparison between the buy data and the replay right data” is disclosed in ‘340 col. 12, line 56 through col. 13, line 39.

As to dependent claim 13, “wherein steps (b)-(f) are performed in response to a pre-buy message, and wherein: the second encryption key and the third encryption key are stored in a smartcard, and the replay right data is generated from the metadata sued the pie-buy message in the smartcard; and the steps of accepting the buy data, comparing the buy data with the replay right data, and decrypting the fourth encryption key using the third encryption key to produce the second encryption key according to the comparison between the buy data arid the replay right data tire performed in the smartcard” is taught in ‘340 col. 21, lines 1-40.

As to dependent claim 14, “wherein the re-encrypted program material and the fourth encryption key ate stored on a media storage device” is shown in ‘340 col. 7, lines 49-55.

As to dependent claim 15, “wherein the control data is temporally-variant” is disclosed in ‘340 col. 28, line 43 through col. 29, line 39.

As to dependent claim 16, “wherein the temporally-variant control data associates an expiration time with the program material” is taught in ‘340 col. 28, line 43 through col. 29, line 39.

As to independent claim 17, “An apparatus for: storing program material encrypted according to a first encryption key for replay, comprising:” is shown in ‘340 col. 7, lines 48-53;

“a conditional access module, for accepting encrypted access control information including the first encryption key and temporally-variant control data, the control access module comprising a first decryption module, for decrypting the access control information to produce the first encryption key” is disclosed in ‘340 col. 4, lines 26-35;

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**“a first encryption module, for encrypting a second encryption key with a third encryption key to produce a fourth encryption key; and a second decryption module for decrypting the fourth encryption key to produce the second encryption key”** is taught in ‘340 col. 6, lines 14-67.

**As to dependent claim 18, further comprising: a tuner, communicatively coupleable to the conditional access module for receiving the encrypted access control information and the program material encrypted according to a first encryption key”** is shown in ‘340 col. 4, line 63 through col. 5, line 12;

**“a third decryption module, for decrypting the program material using the first encryption key produced by the conditional access module; a second encryption module, for re-encrypting the decrypted program material according to the second encryption key; and a fourth decryption module, for decrypting the re-encrypted program material according to the second encryption key”** is disclosed in ‘340 col. 6, lines 23-53.

**As to dependent claim 19, “wherein the conditional access module further comprises: a pre-buy module, for controlling the first decryption module”** is taught in ‘340 col. 12, line 56 through col. 13, line 14.

**As to dependent claim 20, “wherein the access control information further comprises metadata describing at least one right for the program material”** is shown in ‘340 col. 31, lines 7-24.

**As to dependent claim 21, “wherein pre-buy module generates replay right data from the metadata”** is disclosed in ‘340 col. 12, lines 39-67.

**As to dependent claim 22, “further comprising a buy module, communicatively coupled to the pre-buy module”** is taught in ‘340 col. 14, lines 21-67.

As to dependent claim 23, “wherein the buy module comprises: a purchase module; for accepting buy data, and comparing the buy data and the replay right data from the pre-buy module; and a control module for controlling the second decryption module based on the comparison between the buy data and the replay right data” is shown in ‘340 col. 13, lines 14-54.

As to dependent claim 24, “further comprising a billing module, for recording the buy data” is disclosed in ‘340 col. 40, lines 2-5.

As to dependent claim 25, “wherein the second encryption key is stored in the conditional access module” is taught in ‘340 col. 7, line 48 through col. 8, line 37.

As to dependent claim 26, “wherein the third encryption key is stored in the conditional access module” is shown in ‘340 col. 7, line 48 through col. 8, line 37.

As to dependent claim 27, “wherein the conditional access module is releaseably communicative coupleable to: a tuner for receiving the encrypted access control information and the program material encrypted according to a first encryption key; a third decryption module, for decrypting the program material using the first encryption key from the conditional access module a second encryption module, for re-encrypting the decrypted program material according to the key” is disclosed in ‘340 col. 6, lines 23-54;

“and a media storage device” is shown in ‘340 col. 7, lines 48-53.

As to independent claim 28, this claim is directed to the apparatus of the method of claim 1 and is rejected along similar rationale.

As to dependent claims 29-42, these claims contain substantially similar subject matter as claims 2-16, therefore they are rejected along similar rationale



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*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (703) 305-8917. **"After 26 October 2004, the examiner can be reached at (571) 272-3842".**

The examiner can normally be reached from 6:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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8 October 2004

  
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